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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,788	02/17/2000	Richard E. Olson	PH-7076-A	7287

23914 7590 10/06/2004  
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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/505,788	OLSON, RICHARD E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brenda Coleman	1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,10-14,16,20,22,23,25-30,33,35-37,39-45,48,50-52 and 54-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,6,10-14,16,22,23,25-30,33,35-37,40-45,48,50-52,55-58,60-64,66-70 and 72-74 is/are allowed.
- 6) ☒ Claim(s) 20,39,54,59,65 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-4, 6, 10-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52 and 54-74 are pending in the application.

This action is in response to applicant's amendment dated July 15, 2004. Claims 1, 10 and 20 were amended and claims 57-74 are newly added.

### *Response to Arguments*

Applicant's amendments and arguments filed July 15, 2004 have been fully considered with the following effect:

1. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled a), b), c), d), e), f) and h) of the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejection labeled g) in the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive.

g) The applicants' state that "claim 20 has bee amended". However, the definition of R<sup>10</sup> is still present in claim 20 of which there is no variable R<sup>10</sup>.

Claims 20, 39 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

2. The applicants filing of a terminal disclaimer is sufficient to overcome the obviousness-type double patenting rejection of claims 1-4, 6, 10-14, 16, 20, 22, 23, 25-

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30, 33, 35-37, 39-45, 48, 50-52 and 54-56 labeled paragraph 2 in the last office action, which is hereby **withdrawn**.

In view of the amendment dated July 15, 2004, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 20, 39, 54, 59, 65 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of  $R^3$ , which includes the two moieties in the 8<sup>th</sup> line of the definition of  $R^3$ , where the moieties have a box in the middle of each, i.e.  $-CH_2C\Box CH$  and  $-CH_2C\Box C(CH_3)$ .

d) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of  $R^5$ , which includes the seven moieties in the 10<sup>th</sup> and 11<sup>th</sup> lines of the definition of  $R^5$  where the moieties have a box in the middle of each, i.e.  $-C\Box CH$ ,  $-CH_2C\Box CH$ ,  $--CH_2C\Box C(CH_3)$ ,  $-CH_2C\Box C(C_6H_5)$ ,  $-CH_2CH_2C\Box CH$ ,  $-CH_2CH_2C\Box C(CH_3)$ , and  $-CH_2CH_2C\Box C(C_6H_5)$ .

c) Claim 59 is vague and indefinite in that it is not known what is meant by the definition of  $R^{11}$ ,  $R^{11a}$ , and  $R^{11b}$  of which there is no variables  $R^{11}$ ,  $R^{11a}$ , and  $R^{11b}$  in the claim.

**NOTE:** In addition to the rejections outlined above it is herein pointed out to the applicants that the fax, which was submitted July 15, 2004 is of very poor quality. There are many definition in all of the claims and in the nomenclature of the species which are illegible with respect to the -, = and  $\equiv$ . It is advised that the amendment to this office action not be faxed and/or include a copy which is not faxed, i.e. mailed. If the quality of the claims submitted for printing, i.e. in the event of an allowance is comparable to the claims of record, there will possibly be a great magnitude of typographical errors in the printed patent.

***Allowable Subject Matter***

4. Claims 1-4, 6, 10-14, 16, 22, 23, 25-30, 33, 35-37, 40-45, 48, 50-52, 55-58, 60-64, 66-70 and 72-74 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions and method of use of the compounds of formula (I) as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman  
Primary Examiner Art Unit 1624  
October 3, 2004